JUL 22 1970
E. ROBERT SEAVER, CLERK

In the Supreme Court of the United States

No. [redacted] 305

OCTOBER TERM, 1969.

SKEGA AKTIEBOLAG
(formerly Skelleftea Gummifabriks A.-B.)

and

THE ALLEN PUMP CO.
(Trading as The Allen-Sherman-Hoff Pump Company),
Petitioners,

vs.

THE B. F. GOODRICH COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT.

BRIEF OF RESPONDENT IN OPPOSITION.

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In the Supreme Court of the United States

No. 1737.

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FOREWORD.

This is an ordinary action for patent infringement of an ordinary, invalid patent which has never before been litigated. This case meets none of the criteria required by this Court as reasons for granting review on certiorari as set forth in its Rule 19. Petitioners have phrased their "QUESTIONS PRESENTED FOR REVIEW," to conform to these criteria. In actuality, however, the decision of the Court of Appeals for the Sixth Circuit for which review is sought, is not in conflict with any decision of any other court of appeals on the same matter, nor with the trial court, nor

with the statute nor with applicable decisions of this Court. Petitioners seek to relitigate the issues on the merits which were decided uniformly against them in both courts below.

In *Layne and Bowler Corp. v. Western Well Works Inc.*, 261 U.S. 387, 67 L. ed. 712 (1923), this Court dismissed as improvidently granted a writ of certiorari granted to settle a conflict between decisions of two circuit courts of appeals with respect to the validity and scope of a patent where, upon examination, it was disclosed that there was in fact no conflict between the decisions.

In *Keller v. Adams-Campbell Co. Inc.*, 264 U.S. 314, 319, 68 L. ed. 705, this Court dismissed a writ of certiorari as improvidently granted where upon close examination it was found that no important question was involved concerning the rights of one beginning manufacture of an alleged infringing device before reissue of a patent. Mr. Chief Justice Taft stated: "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and noninfringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of circuit courts of appeal on the *same patent*." (Emphasis supplied.)

In *General Talking Pictures Corp. v. Western Electric Co. Inc.*, 304 U.S. 175, 178-179, 82 L. ed. 1273 (1938), this Court in refusing to consider questions raised in the brief on the merits and not brought forward in a petition for writ of certiorari, noted that there was nothing in the lower courts' decision on either of the added questions to warrant review by this Court. In so doing, Mr. Justice Butler stated: "Granting of the writ would not be warranted merely to review the evidence or inferences drawn

from it. * * * Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals."

Nor is there any occasion at bar to review the merits of the patent in suit. No other courts have decided anything about the patent in suit. Moreover, the patent in suit is, on the face of the decisions of the courts below, without noticeable merit anyhow. The trial court found and the Court of Appeals affirmed that the difference between the patent claims in suit and the prior art was "trivial." Finding of Fact No. 29, AP 24.* This is a broad general finding which refers to its preceding supporting findings, such as: Nos. 6, 12 and 15 that the claimed combination was old with only the means for holding the lifting means "altered or improved"; Nos. 16 and 17 describing the lifting action and the antiquity of integral as well as separate lifting means; No. 19 that the stresses, forces and load tending to detach tires from vehicle rims are substantially the same as those to which lifters, i.e. lifting means, are subjected in ball mills; No. 20 that the prior Straus and Overman patents taught, in substance, the same means for holding the old rubber cushion tires in their rims as claimed in the patent in suit; No. 28 that the *difference* between Straus and Overman and claims 1 and 2 of the patent in suit "lies primarily in the use for each structure"; No. 21 describing the teaching of the prior Porteous patent and, No. 27 specifying the precise and minute *difference* between Porteous and the patent in suit.

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* Our references to the Appendices to the Petition will be abbreviated to "AP" followed by the page number.

NO QUESTION IN THIS CASE IS WORTHY OF REVIEW.

Respondent's position is that nothing done or omitted by the courts below raised any question worthy of or warranting review by this Court. This Court in its sound judicial discretion will discover and decide whether or not there are special and important reasons for granting the Petition. Respondent contends there are none.

Petitioners' questions include the bold assertion that the Court of Appeals for the 6th Circuit, the District Court for the Northern District of Ohio, *as well as "the Federal Courts generally,"* do not understand, or are *unable to understand,* what this Court taught and required on the point of obviousness in *Graham v. John Deere, Calmar and Colgate v. Cook,* 383 U.S. 1, *U. S. v. Adams,* 383 U.S. 39, *Anderson's-Black Rock v. Pavement Salvage,* 396 U.S. 57 cited in the Petition, and, necessarily, *Hotchkiss et al., v. Greenwood et al.,* 11 Howard, 248, 265.

Respondent's attorneys suggest that there is nothing about the case at bar to invite review by this Court of whether or not its illustrious decisions in these cases are "understandable by the Federal Courts generally." It should suffice to show here that the courts below in this case lacked no understanding of this Court's teaching in these cases.

How petitioners aimed to interest this Court in the QUESTIONS PRESENTED FOR REVIEW was obscure to respondent's attorneys until they noticed petitioners' repeatedly and mistakenly asserted premise that "The *relevant and material facts* in the case *are undisputed.*", (emphasis supplied), page 6, lines 6 and 7 of the Petition and again in substance on page 10, under the heading "Utility and Novelty," and again on page 19 in the first paragraph of the text saying, "In the present case *the facts*

were not in dispute; the findings are descriptive and conclusionary (sic)." (Emphasis supplied.)

By asserting that the relevant and material facts were not in dispute, petitioners have allowed themselves (1) to fill their Petition with many mistaken factual recitations as if true and undisputed, and (2) to advert to the findings of fact made by the trial court as if they were merely irrelevant gratuities or conclusions of law or law and facts, beyond the scope of Rule 52 (a), and in breach of *Graham*, *Calmar* and *Anderson's-Black Rock*.

Respondent asserts that the relevant and material matters of fact which were critical to decision and judgment in this case were vigorously disputed. The trial court's repeated reference to the testimony of the witnesses for both parties in its findings of fact Nos. 12, 13, 15, 16, 17, 19, 22, 24, 25 and 27 demonstrates its thoughtful resolution of many disputed questions of relevant and material facts.

RESPONDENT'S COUNTERSTATEMENT OF THE CASE.

PROCEEDINGS IN THE COURTS BELOW IN THIS CASE, PAGE 5 OF THE PETITION.

Early in the proceedings in the trial court plaintiffs-petitioners variously accused two substantially identical forms of defendant's products as infringing the patent in suit. In one form the metal reinforcing bar in the rubber lifter was vulcanized and bonded into the lifter following the teaching of the prior art Porteous patent, AP 7. In the other form, the metal reinforcing bar was "loose," not vulcanized or bonded in the rubber body of the lifter, following the teaching of prior art Straus and Overman patents, AP 12 and 13. Bolts from the metal bars to the ball mill shell or drum secured the bars and lifters which

in turn secured the liners of both forms in the same way in and to the drum or shell of the mill. On discovery in about May, 1967, the vulcanized form was excused from the charge of infringement. The unvulcanized or "loose" form was then alone accused. By the second amendment to the Supplemental Complaint in December, 1967, the vulcanized form was also accused. Before the trial the vulcanized form was again excused. This conduct will be related to petitioners' abandonment of its claim to its vulcanized form in the U.S. Patent Office, page 9 below.

Conclusion of Law No. 4 held the claims in issue of the patent in suit invalid under Sec. 103.

Conclusion of Law No. 5 held the alleged invention of the patent in suit nothing but a new use for the cushion tire holding or clamping means of the prior Straus and Overman patents.

Conclusions of Law Nos. 6 and 8 held the issue of infringement to be moot.

Conclusion of Law No. 7 held defendant had carried its burden of proving invalidity of the claims in issue of the patent in suit.

The Court of Appeals for the 6th Circuit affirmed the trial court's finding that the combination claimed in the patent in suit was an old combination within the scope of the prior art, AP 2. The Court of Appeals not only affirmed that finding but *also* affirmed the trial court's further findings and/or conclusions that the patent in suit was obvious, AP 4.

The Court of Appeals made its own examination of the prior art patents to Porteous, Haushalter, Lawler and Reed and *made its own findings* about likeness as between the prior art features, retaining means and combinations and the patent in suit, AP 2 and 3.

The Court of Appeals found "no merit in the Appellants' contention that the art of securing rubber tires to metal rims is not analogous to the art of securing lifting means to ball mill shells.", and quoted and endorsed the trial court's finding No. 19 in respect to the sameness of the loads and forces tending to detach tires from their rims and lifters from ball mill drums. And the Court of Appeals endorsed the trial court's finding that if the Svensson patent in suit contained any novelty in respect to the holding means of Porteous, "it was merely a new use of the clamping means" of Straus and Overman, AP. 3 and 4.

THE BACKGROUND AND NATURE OF THE PATENT IN SUIT, PAGES 6-9 OF THE PETITION.

Respondent will try to avoid arguing the merits and criticizing harmless, irrelevant material.

This case involves a situation substantially identical with *Graham*, *Calmar* and *Anderson's-Black Rock*, and, therefore quite unlike *U. S. v. Adams* as the decisions and findings at bar in the courts below demonstrate.

"The relevant and material facts in" this "case" were vigorously "disputed," as shown above. Petitioners' assertions to the contrary, page 6 of the Petition, are mistaken and misleading.

Petitioner to the contrary notwithstanding, page 7 of the Petition, the Gammeter patent was used by respondent with fine commercial acceptance and success. An early installation of a Gammeter type rubber lined mill was made by respondent at the Homestake Mine in about 1925. Six years later the chief metallurgist of the Homestake published an article telling about the continued success of this rubber lined mill and the Homestake's replacement of iron linings by rubber linings because of the superior performance of the latter.

Contrary to Petitioners' statement on page 8 of their Petition, there is no evidence in this case that the Porteous lining failed to pass any test, or that any vulcanized bond between rubber and metal broke under impact forces of the mill charge.

Petitioners would have it on page 8 of their Petition that their ball mill linings were the very first rubber linings to meet the technical requirements of the industry, that all previous efforts failed, that numerous experts, including respondent's, worked continuously for 40 years in a vain effort to solve practical problems of fastening the rubber slabs to the mill shell, and that the patent in suit solved all the problems that plagued the art. The trial court found in its finding No. 30, AP 24:

> "30. The scope and content of the prior art taught and embraced in substance all the solutions to all the problems which the patent in suit purported to solve. (See Findings above.)"

There is no competent evidence of any failure of rubber ball mill linings, except that petitioners' Mr. Svensson testified that Skega's first designs according to Fig. 3 of the patent in suit failed in use in ball mills and had to be redesigned to withstand that hard usage, Petitioners' brochure, Ex. 63 opposite page 8 of the Petition. It is true, as petitioners do not mention, that the relatively high cost of rubber compared to the low cost of cast metal made the use of rubber linings noncompetitive from about the time of World War II until the 1960's.

Petitioners' self-serving romancing about the virtues and accomplishments of the patent in suit on page 8 of the Petition are unworthy of our adversaries and remote from the evidence in this case. The record shows that respondent reentered the rubber ball mill lining business in the '60's when the relative price of rubber and steel in the

United States returned to what it was in the '20's and 30's when respondent first successfully pioneered and promoted the art.

Petitioners neglected to mention that two forms of their invention are described and praised equally in the Svensson patent. In the form shown in Figure 3 of the patent at AP 5 attached to the Court of Appeals decision, the clamping bar 6 is "inserted" (meaning removably inserted) but not vulcanized and secured in the slot 5 in the lifter 3. In Figure 4 the clamping bars 9 and 11 are placed in and vulcanized in the corresponding slots in the lifters 10. Mr. Svensson, one of the inventors and general manager of petitioner, Skega, admitted the essential equality of these forms on cross-examination.

The original claims of the Skega patent application as originally filed included clamping means merely "inserted" (but not vulcanized) in the slot in the lifter or, alternatively, "secured by vulcanization." The Porteous patent was cited against the claims of the Svensson application. The clamping bar 8 in the Porteous patent AP 7 was vulcanized in the lifter. To distinguish from Porteous, petitioner, Skega, abandoned its effort to cover rubber lifters with metal bars vulcanized therein. Similarly, petitioners dropped their accusation of respondent's vulcanized form, page 6 above.

By yielding one of two equal forms of its alleged invention, petitioner gained a patent for the other.

Petitioners propose on pages 9 and 10 of the Petition that silence in the decisions below about the presumption of validity speaks in petitioners' favor on that point. But the trial court's Conclusion of Law No. 7 that defendant (-respondent) "carried its burden of proving invalidity" disposed of the presumption. Petitioners say on page 10 of the Petition that utility and novelty of the patent in suit

"have been admitted or not contested." In the sense that the patent in suit teaches and claims only an old combination, Findings 12-15, AP 19 and 20, utility of the old combination is clear enough and utter lack of novelty is also clear. In the sense that one element, the attaching or holding means, of the old combination was improved, Finding 12, novelty might have appeared, but even the attaching and holding means was old, Findings 20 and 28, AP 21 and 23 and Court of Appeals first paragraph AP 4.

ARGUMENT.

RESPONDENT'S OPPOSITION TO PETITIONER'S REASONS FOR ALLOWANCE OF THE WRIT.

The Basic Factual Inquiries of Graham v. John Deere Were Applied Correctly by the Courts Below in This Case:

This chapter will respond to petitioners' argument comprising pages 10-17 inclusive, of the Petition. Whereas petitioners protest the failure of the courts below to understand or follow *Graham*, examination of these pages reveals that petitioners' principal grievance is that the courts below refused to adopt petitioners' proposed findings to the effect that the prior art was a failure. Petitioners call this the "central issue"—"the failure of the prior designs" etc. This is plain and simple reargument of the same untenable contention on the merits which the trial court rejected once and the Court of Appeals rejected twice; the second time on Petition for Rehearing. On page 14, petitioners protest the courts below didn't find enough differences between prior art Porteous and Skega wherefore the courts below failed "to meet the substantive requirements of Graham." This is absurd. On the merits Mr. Svensson admitted the substantial and essential iden-

tity between Porteous and the patent in suit. On the issue at law on the Petition here, nothing in *Graham, Calmar* or *Anderson's-Black Rock* requires any court to make mistaken or unsupportable findings of fact to correspond with romantic theories of the unsuccessful party.

Petitioners reveal their primary and continuous ambition to reargue the now thrice briefed merits of the case by saying on page 15 of the Petition:

> "*We frankly feel* that the structure, operation and function of rubber lined ball mills is so distant from that of the old solid rubber tires * * *." (Emphasis ours.)

But the trial court heard conflicting testimony on this point and found for respondent in Finding 19, AP 20.

The rest of petitioners' argument through page 17 of the petition repeats and repeats the mistaken theory that respondent failed to solve "the problem" and the courts below failed to agree with petitioner on this point. This has nothing to do with the Questions that petitioner has presented for review.

Petitioners protest against the trial court's findings, Findings Nos. 22-25, that it was obvious to the witness Phillip F. Allen to follow the prior art and solve the "problem" allegedly waiting solution by the patent in suit. The trial court's findings were based on Allen's testimony in open court, direct and cross, supported by his contemporaneous documentary evidence and original physical exhibits. The findings are eminently proper. They are confined to the original work done by Allen and the Gates people and to the fact that "It was obvious to Allen * * *." This plain and simple fact certainly weighed in the scale of evidence about the "level of ordinary skill in the pertinent art." Petitioners' concern with the merits is not relevant to the Questions presented by them for review.

The basic factual inquiries relevant to the determination of obviousness or nonobviousness as stated in *Graham* are repeated here, as follows:

> "Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined."

In this case the district court correctly applied these tests in making its findings of fact and conclusions of law.

Finding No. 18, AP 20, determined the scope and content of the prior art relevant to the patent in suit as encompassing not only the ball mill art but also the art of clamping rubber cushion tires to the rims of vehicles. Findings Nos. 12 to 17 and 21, AP 19-21, describe the content of the prior art of ball mill linings. In Finding No. 19 the trial court determined that the art of holding rubber cushion tires on the rims of road vehicles is analagous to the art of holding rubber lifters in the drums of rotary grinding mills. In Finding No. 20, the trial court found the content of the art of securing rubber cushion tires to the rims of vehicle wheels in the prior Straus and Overman patents.

The particular differences between the rubber lined ball mill art and the combination claimed in the patent in suit are set forth in Findings 12 and 27 and in comparison with Finding 6 about the patent in suit. Finding No. 27 is directed to the difference between the Porteous patent and the Svensson patent in suit. Finding No. 12 established the identity between the old combination of the same elements in the prior art and in the patent in suit. This narrowed the area of possible difference down to the trivial difference between the vulcanized bond of the reinforcing

bar in the Porteous lifter (as also disclosed and praised in Fig. 4 of the patent in suit) AP 5, and the unvulcanized, but equal, relation of the bar to the lifter of Fig. 3 of the patent in suit, AP 5.

It is mentioned in passing that the old combination of the Glencoe patent in *Graham*, the old combination of the Livingstone patent in *Calmar*, and the old combination discussed in *Anderson's-Black Rock*, each narrowed the area of difference that distinguished the patents there in suit to the "inconsequential" as contended by and found for *Calmar*.

Finding No. 12, in the last sentence thereof, expressly found that the difference, if any, between the Porteous patent and the patent in suit lay in the means for holding the lifting means. See also Finding 21, AP 21. Even if this particular sentence of Finding 12 be deemed conclusory, it is based on the prior primary findings in Finding 12 and the specific findings in Nos. 20 and 27 and is fully supported thereby. In sum, Findings 12 and 27 laid the foundation for Finding 29 that the difference between the prior art and the Svensson patent in suit is "trivial."

As to the holding or attaching means itself, Finding 28, AP 23 & 24, determined that attaching means in the Straus patent and in the Overman patent is the same as the attaching means in the patent in suit and does the same work in the same way; the difference between the two lying primarily in the use intended for each. This reduced the difference to very little indeed.

Petitioners complain that there is no valid evidence and no valid findings as to the level of ordinary skill in the pertinent art. We suggest that the level of ordinary skill is determined in large part by the content of the prior art. Contributions to the art continually update and increase the level of ordinary skill. This is a purpose and one of

the principal rewards of our patent system. It comprises the glow and vitality of the public domain in the useful arts. One at the level of ordinary skill in the art is one who is blessed with and is capable of applying the wealth of the public domain to solving work-a-day problems as they arise. The work of the witness Phillip F. Allen is a concrete example. Proceeding independently with no knowledge of the Skega lining or the patent in suit, Allen designed, installed and operated a rubber lining for a ball mill as set forth in Findings 22 to 25 as discussed above. His work was contemporaneous with Skega in the United States.

Petitioners complain that some of the findings of the trial court are conclusory. The other findings of basic facts from which the allegedly conclusory Findings are inferred, or upon which they are predicated, are dismissed by petitioners as being "simply descriptive" of the prior art and "merely neutral background material." But compare *Commissioner v. Duberstein*, 363 U.S. 278, 292, 4 L. ed. 2d 1218 (1960). In the cited case this Court held findings of fact insufficient where the trier of fact made only the simple and unelaborated finding that a particular transfer of property constituted a "gift." At bar the findings that are dubbed by petitioners as "simply descriptive" and "merely neutral background material" comprise findings made on disputed facts from which the findings about which petitioners complain, are logically inferred. The findings at bar are not "simple and unelaborated" as in *Commissioner v. Duberstein*, but are taken with and supported by explicit concrete findings at the root and premises of the truth.

The Court of Appeals Did Not Use Rule 52 (a) Incorrectly to Limit or Avoid Its Review of the Question of Obviousness:

Petitioners contend that the Court of Appeals below avoided reviewing reviewable findings and conclusions as if it were restrained by the "clearly erroneous" limitation. The Court of Appeals did not so confine the scope of its review. The Court of Appeals affirmance of the judgment, findings and conclusions of the trial court was so wholehearted that it had no occasion to question its power to test any particular finding or conclusion.

In *Cordovan Associates, Inc. v. Dayton Rubber Co.*, 290 F.2d 858 (1961), the Sixth Circuit Court of Appeals reconsidered on remand from this Court, *Dayton Rubber Co. v. Cordovan Associates*, 364 U.S. 299, a decision involving the "clearly erroneous" rule in light of this Court's decisions in *Commissioner v. Duberstein, supra.* In *Cordovan Associates,* the Court of Appeals stated its understanding of the law relating to the scope of appellate review under the eye of this Court. Respondent respectfully suggests the Court of Appeals for the Sixth Circuit understood and stated the law correctly in *Cordovan Associates* and applied it correctly in the case at bar.

No Conflict Between 6th, 4th and 9th Circuits:

Payne Metal Enterprises, Ltd. v. McPhee, 385 F.2d 541 (9th Cir. 1967) and *Tidewater Patent Development v. Kitchen,* 371 F.2d 1004 (4th Cir. 1966) which Petitioners allege are in conflict with the Sixth Circuit Court of Appeals decision in this case stand for the same propositions of law about appellate review as stated in *Cordovan Associates* and applied here at bar.

In *Cordovan Associates* the 6th Circuit Court stated that the "clearly erroneous" rule applied not only to basic

facts but also to factual inferences drawn from undisputed or well founded basic facts. Further, the court stated that not all findings labeled as findings of fact are binding on an appellate court. Where a finding so designated is actually a conclusion of law or a mixed finding of fact and conclusion of law it is not binding on the appellate court. If a finding is one of ultimate fact in the making of which the application of legal principles is involved, it is subject to review.

The Court of Appeals in *Cordovan Associates* then considered a particular finding of the district court, and held it must be considered with the other findings and not separate and apart from them, and held it to be a reviewable conclusion of law or a reviewable mixed finding of fact and law.

Cordovan Associates demonstrates plainly that the Sixth Circuit Court of Appeals is quite aware that it is not bound by findings of fact that contain, or border on conclusions of law.

In *Tidewater Patent Development v. Kitchen, supra,* contended by Petitioners to be in conflict with the decision of the Court of Appeals in this case, the Fourth Circuit Court of Appeals merely refused to follow legal conclusions of the trial court which were apparently called findings of fact. The Court noted that most of the evidence was documentary and could be examined by it as well as by the trial court, which the Appeals Court proceeded to do and then corrected the erroneous conclusion of the trial court.

In *Payne Metal Enterprises v. McPhee, supra,* which Petitioners contend is in conflict with the Court of Appeals decision in this case, the Ninth Circuit Court of Appeals merely refused to be bound by a conclusion of nonobviousness though labeled a finding of fact, just as the Sixth

Circuit Court of Appeals refused to be so bound in the *Cordovan* case. The Ninth Circuit Court of Appeals then considered the prior art patents and corrected the erroneous conclusion of law made by the trial court.

On page 18 of the Petition petitioners have omitted from their quotation of the Court of Appeals' decision substantially all the Court said and did on AP 3 and the first paragraph of AP 4. These omitted parts demonstrate that the Court of Appeals functioned freely in its review, modification and affirmance of the trial court's findings and conclusions without any mistaken inhibition from the "clearly erroneous" rule.

Beginning at the top of AP 3 the Court of Appeals made its own independent comparison of the Porteous patent with the Svensson patent in suit, saying of Porteous that it "comprised the same features and used identical retaining means * * * homologous to the Svensson lifting means." This finding of "identical retaining means" in Porteous and in the patent in suit went a step further than the trial court's Finding of Fact No. 12, AP 19, which suggested that the retaining means of Porteous was "altered or improved" in the patent in suit.

Further in respect to the old combination of the lifters, liners and holding or retaining means of Porteous in comparison with the Svensson patent in suit, the Court of Appeals categorically endorsed the trial court's Finding No. 28, AP 23-24, and Conclusion of Law No. 5, AP 25, saying, "that if Svensson's" retaining means "was novel at all, in light of the Porteous patent" it was merely a new use of Straus and Overman.

The Court of Appeals then made its own examination of the Haushalter patent, and found the identity between Haushalter and the patent in suit in explicit affirmation of the trial court's Finding No. 13, AP 19.

Similarly the Court of Appeals made its own examination of the Lawler and Reed patents and made its own finding in affirmation of the trial court's Finding No. 14, AP 19, saying that it found in Lawler and Reed "virtually the identical combination" compared with the patent in suit except for changing the material from metal to rubber.

Then the Court of Appeals beginning in about the middle of AP 3, made its own review in law and in fact on the point of whether or not the art of securing rubber cushion tires to the rims of vehicles was analogous to the art of securing lifters in and to the drums of ball mills. It cited authority at law and quoted from the trial court's Finding No. 19, AP 20 and 21, in fact in respect to the work done by the clamping means in both instances; the trial court citing the testimony of defendant's expert witness, Kramer, in support of its finding.

These uninhibited acts and deeds of the Court of Appeals illumine the second of the two paragraphs of its decision which petitioners quoted on page 18 of the Petition. Respondent suggests that the first phrase of the paragraph is a recap of its and the trial court's findings and/or conclusions that the patent in suit comprised merely an old combination wherein one element, if "novel at all, in light of Porteous" was "merely a new use" etc. Respondent also suggests that the second phrase beginning "but also that it was obvious * * * to persons having ordinary skill in the art of clamping rubber to metal" comprised its affirmation of a second and independent group of findings and conclusions of fact, mixed fact and law and law based on the testimony of Appellee's witnesses Kramer and Allen, among others, Findings 16, 19, 22-25, the logical inferences therefrom, Findings 26, 29 and 30 and the Conclusions of Law Nos. 4, 5, 6 and 7.

The concluding sentence of this paragraph reading,

> "In so crediting the testimony of the Appellee's experts we cannot say that the District Court erred in fact or law. Rule 52(a),"

taken with the things the Court of Appeals did in the preceding parts of its decision, as discussed above, forbids one to say that the Court gave more than proper heed to the trial court's findings on disputed testimony because it reviewed or made all other findings, conclusory findings and conclusions of law or mixed fact and law as uninhibitedly and thoughtfully as this Court taught, exemplified and required in *Commissioner v. Duberstein; Dayton Rubber Co. v. Cordovan Associates,* 364 U.S. 299, 5 L. ed. 2d 90; *Graham, Calmar* and *Anderson's-Black Rock.* It follows that the Sixth Circuit Court of Appeals fell into no conflict in this respect with the Courts of Appeal of the Fourth and Ninth Circuits.

Nothing about United States v. Adams Suggests the Skega Patent Should Have Been Sustained:

Firstly, "the Adams battery is novel" 383 U. S. 39, 50. Secondly, "the Adams battery was also nonobvious," as this Court found and affirmed on page 51 of the official report. Nothing before this Court on or appended to the Petition suggests either novelty or nonobviousness in the Svensson patent in suit.

SUMMARY AND CONCLUSION.

The Petition is overburdened with reassertion of and reargument about the merits upon which petitioners failed to carry their burden in the courts below. Respondent has shown that petitioners' representations to this Court that the relevant and material facts in this case were *undisputed* were gravely mistaken, but were necessary premises to support the Petition. Since many relevant, material and basic facts were found by the trial court on conflicting testimony and disputed evidence, and petitioners' premises about undisputed facts are invalid, petitioners' argument and conclusions based thereon must fail.

Respondent contends it has also shown that the Questions Presented for Review by petitioners, and their Reasons for Allowance of the Writ, were predicated on corollaries to petitioners' mistaken premises, namely, that the courts below made, reviewed and affirmed findings of fact that had nothing to do with the case, and were mere "background material", avoiding the "central issue" of Skega's success compared with the failure of the prior art. Petitioners' real complaint is the courts below failed to make findings and draw conclusions pleasing to petitioner.

With everyone out of step but petitioners, it is not to be wondered that they have tried to interest this Court in the proposition that *Graham, Calmar* and *Anderson's-Black Rock* are not "understandable by the Federal Courts generally." Respondent suggests this also reveals the fallacy and futility of petitioners' plea.

Respondent has shown that the courts below understood and followed *Graham, Calmar* and *Anderson's-Black Rock* carefully and wisely in respect to obviousness and otherwise, and made the inquiries required in those cases. Respondent has shown the parallel between the

evidence at bar and in these cited cases in respect to the patentees wrongful efforts there and here to recapture old combinations and remove them from the public domain.

The courts below also made the basic inquiries required in *Graham et seq.* into the facts that demonstrated obviousness in the mere double use of the old and "improved" holding or attaching means of the prior art as in *Hotchkiss v. Greenwood.*

Respondent has also demonstrated the absence of noticeable conflict between the 6th, 4th and 9th Circuit Courts of Appeal in respect to their duty and willingness to review findings and conclusions without breach of the letter or substance of Rule 52 (a).

In sum, respondent suggests it has shown the propriety and correctness of all the works done by the courts below in this case. It has shown the closeness of this case to the leading authorities of this Court in point of obviousness and the remoteness of this case from *U. S. v. Adams.* And respondent has shown that this is an ordinary action for patent infringement of a very ordinary patent presenting no important question for this Court to review.

Respondent respectfully solicits this Court's denial of the Petition.

Respectfully submitted,
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Cleveland, Ohio,
20th July, 1970.

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SEP 28 1970
E. ROBERT SEAVER, CLERK

In the Supreme Court of the United States

OCTOBER TERM, [redacted] 1970

No. 305.

SKEGA AKTIEBOLAG
(formerly Skelleftea Gummifabriks A.-B.)
and
THE ALLEN PUMP CO.
(Trading as The Allen-Sherman-Hoff Pump Company),
Petitioners,

vs.

THE B. F. GOODRICH COMPANY,
Respondent.

PETITIONERS' REPLY BRIEF ON THEIR PETITION FOR WRIT OF CERTIORARI.

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PETITIONERS' REPLY BRIEF ON THEIR PETITION FOR WRIT OF CERTIORARI.

I.

Respondent's Brief, dated 20th July, 1970, makes it clear that Respondent cannot answer, and has sought to direct attention away from, the main thrust of the Petition, i.e., Petitioners' position.

On Page 2, that Brief attempts to direct attention away from Petitioners' position by asserting that Petitioners are "seeking to relitigate the issues on the merits," and on page 4, dismisses that position as being "a bold assertion."

II.

Petitioners did not "seek to relitigate the issues on the merits." Petitioners referred to one of the "factual inquiries" in the *Graham* case to show that the decisions in

this present case did not follow the rule of the *Machine Co.* and *Bates* cases. In making that point, it was necessary to refer to certain facts to inform the Court of what was involved.

Incidentally, Respondent is guilty of the very thing that it charges against Petitioners; i.e., dealing extensively with fact issues. Although it is said on page 7 of the Answer Brief that Respondent "will try to avoid arguing the merits," that Brief shows that Respondent failed in that effort and also made several statements which Respondent knew or should have known were false.

III.

Respondent's principal "answer" to the Petition was an assertion that there were many disputed relevant and material facts in the case contrary to our claim. See Respondent's Brief pp. 4, 5, 7, 11, 20, 4-14. The "answer" does not seem responsive to the legal issues in the Petition. In any case, however, we are satisfied that indeed there are no such disputed facts (as distinguished from conclusions) as is evident from the findings of the trial court, and can readily be ascertained from the Record. Interestingly, despite its fervor on the point, Respondent failed to set forth a single such disputed fact.

IV.

The position of Petitioners is that (1) the *Graham* case did not bar the application of the rule of the *Machine Co.* and *Bates* cases, and (2) the courts below generally, and the courts in this case particularly, did not understand the *Graham* case to mean that they should continue to follow the rule of those cases. The rule of those cases is that in determining the validity of a patent, each of the three factors of structure, mode of operation and results

must be considered. That position was broadly stated on pages 3 and 11 of the Petition and was concisely stated on pages 14 and 15 where the *Machine Co.* and *Bates* decisions of this Court were cited and quoted as authority.

Respondent has completely evaded those parts of the Petition and has not denied Petitioners' assertion that the courts below did not follow the rule of the *Machine Co.* and *Bates* cases.

This Court first stated the foregoing rule in the case of *Seymour v. Osborne*, 11 Wall. 516, 518 which was decided in December, 1870.

That rule was clarified and expanded to apply to both infringement and validity in the cases of *Machine Co. v. Murphy*,[1] 97 U.S. 120, 125 (1877) and *Bates v. Coe*, 98 U.S. 31, 42 (1878). A quotation in the *Bates* case appears on page 14 of the Petition.

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[1] On page 125, this Court said:

"Except where form is of the essence of the invention, it has but little weight in the decision of such an issue, the correct rule being that, in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same result, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different functions or in a different way, or produce a substantially different result.

"Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape or form the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way the device works, and at the result, as well as the means by which the result is attained.

(Continued on following page)

The rule of the three foregoing cases was followed by this Court from time to time down to 1966 when the *Graham* case was decided. Some of the cases following that rule are listed as follows:

Loom v. Higgins, 105 U.S. 580, 591 (1881);
Expanded Metal Co. v. Bradford, 214 U.S. 366, 380 (1908);
Mineral Separations, Ltd. v. Hyde, 242 U.S. 261, 268 (1916);
Electric Cable v. Edison, 292 U.S. 69, 80 (1934);
Graver Mfg. Co. v. Linde Co., 339 U.S. 605, 608 (1949).

It is believed that this Court has never deviated from that 100-year old rule.

That Petitioners' position as to the failure of the courts in this case to follow *Machine Co.* and *Bates* is sound and unanswerable is shown on pages 14 and 15 of the Petition where findings of the Lower Court are discussed.

On page 14 it is said, with respect to the "factual inquiry" of the "differences between the prior art and the claims at issue," that the Trial Court's Finding No. 27 fails

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(Continued from preceding page)

"Inquiries of this kind are often attended with difficulty; but if special attention is given to such portions of a given device as really does the work, so as not to give undue importance to other parts of the same which are only used as a convenient mode of constructing the entire device, the difficulty attending the investigation will be greatly diminished, if not entirely overcome. *Cahoon v. Ring*, 1 Cliff. 620.

"Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape. Curtis, Patents (4th ed.), sect. 310."

to set forth *all* the structural differences *as well as any of the differences in function, operation and results* between the Porteous and Skega patents. On page 15 it was said, with respect to the same "factual inquiry" as applied to the Straus, Overman and Skega patents, that the Court's Finding No. 28 did not consider the differences in structure, *function and purposes* of those patents. Respondent did not, and cannot, deny any of those charges.

Thus, the courts below did not follow, in fact clearly violated, that 100 year old rule of this Court.

It seems clear that the instructions set out in the *Graham* and *Black Rock* cases have been understood by the lower courts, generally, to mean that they should consider *only* differences in structure in deciding patent validity. Both the *Graham* and *Black Rock* cases stressed strict observance of "three basic factual inquiries," one of which was that "the differences between the prior art and the *claims at issue*[2] are to be ascertained." Since the Skega patent is for apparatus only structure was, or could be set forth in the patent claims. Since neither mode of operation nor results are included or includable in apparatus claims, the expression "claims at issue" actually means that only structure is to be considered. Since this Court did not mention mode of operation and results in that factual inquiry in either of those cases, it might well be assumed that this Court intended that neither of those factors was to be considered in determining the validity of an apparatus patent. However, as was stated in the *Machine Co.* and *Bates* cases, validity is to be determined on the basis of the three factors of structure, mode of operation and results.

Apparently the courts in the numerous lower court decisions handed down subsequent to the *Graham* and

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[2] Emphasis added.